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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,086	03/16/2004	Garrett Blythe	MTV-010	4038

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EXAMINER	
D AGOSTINO, PAUL ANTHONY	
ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,086	BLYTHE ET AL.	
	Examiner	Art Unit	
	Paul A. D'Agostino	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-12,14-18,20-24 and 27-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-12,14-18,20-24 and 27-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 August 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/5/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 05/05/2009. Claims 1-2, 10-12, 15, 17-18, and 20-24 have been amended. Claims 25-26 stand cancelled and Claims 4-5 and 13, and 19 have been newly cancelled. Claims 25-27 (which should be numbered 27-29) have been newly added. Claims 1-3, 6-12, 14-18, 20-24, and 27-29 are now pending in this application.

Claim Objections

1. New Claims 25-27 should be renumbered 27-29. Appropriate attention is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-8 and Claims 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-8 and Claims 14-17 depend from cancelled Claim 5 and Claim 13, respectively, making determination of the scope of Claims 6-8 and Claims 14-17, indefinite.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 6-12, 14-18, 20-24, and 27-29 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent Pub. No. 2002/0086732 to Kirmse (Kirmse) of record or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kirmse.

Kirmse discloses a client-server system including a plurality of game clients, a game server, a plurality of messenger clients, and a messenger server. The game server includes logic to operate a multiplayer game using inputs from and outputs to an active game set of game clients, wherein game clients other than those in the active game set can join an active game by supplying the game server with a reference to the active game. The messenger server includes logic to forward messages from a sender messenger client to a receiving messenger client (para. 0008). Additionally, logic is included for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee. Further, Kirmse discloses in Fig. 2 invocation program code 34 [0037] as part of the user terminal usable by an invitee to join a game currently executing on the game client 20 (1) and known sofware development kit (SDK) programs [0059-0061] typically provided by game manufacturers.

In Reference to Claims 1, 18, 20, and 27-28

Kirmse discloses a system (Fig. 1 10) and method for facilitating multiplayer

gaming over a computer network (16), the system comprising: a client program (20(1)) running on a game {computer} terminal (12) with a computer-readable storage medium and computer-executable program instructions ("memory" [0030-0031] and "client program" programmed to carry out the method of Fig. 6) that automatically detects when selected individuals are playing certain multiplayer games on the computer network (Figs. 1 and 8-10; paras. 0029 and 0053), notifies a user of the games and the selected individuals playing the games (para. 0053) and wherein the program detects one or more of the games are running on the terminal (Figs. 9-10 and paras. 0053-0057 e.g., as tom123494949 enters a game to play, the "available" smiley indicator next to tom123494949's user identifier of Fig. 8 switches to an activity name in which tom123494949 is interacting with as shown in Fig. 9." (para. 0053).

Further Kirmse discloses the client program searching for and detecting when one or more of the games are executing on the terminal and communicating data identifying the running games and the user over the computer network (Fig. 2 wherein client terminal has invocation program code 34 and client variables 36 identifying the games and user information ("particular game being played and how to invoke the game client"" [0037]) usable by an invitee to invoke their own game client to join in a game currently playing [0037]. This information can be sent to messenger 38 [0038] in the event an appropriate system development kit such as the one in [0059-0061] is not provided.

If Applicant does not agree with Examiner's argument then it would have been obvious to automate the manual process of executing a game and logging into the

game of the host to provide game and user information. Applicant has provided "Kirmse relies on the game developers to have installed software development kit (SDK) code into their game in order to communicate with Kirmse's messaging client and for the game itself to notify Kirmse's messenger that it is executing. If the game does not contain this code, Kirmse's messenger has no knowledge that the game is executing, even if it could determined that the game is installed" (see Applicant's Arguments/Remarks page 9). In the absence of the game developer's code installed, the player merely starts the game and logs on to the game server to enter requisite information. Applicant's client program serves to automate this manual logging in process. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a program when one is not provided to facilitate logging in to a game server, since it has been held broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

Lastly, Kirmse is silent on a second program which is separate from the {which is not in communication with the} games executing on the terminal determining a connection status of the executing game(s) and communicating a connection status to the client program.

However, according to Applicant, "Kirmse … instead relying on the game, and its implementation of the SDK" and Kirmse [0059-0062] (see Applicant's Arguments/Remarks page10). Examiner reasonably contends that the claim amendments merely automate the manual process of communicating the connection

status described in [0058] as an alternative to the messenger clients "to notify other end users that the notifier is currently in an online game" [0007]. Thus, it would have been obvious as previously explained to replace the manual process of delivering a connection status to the client program with a second program.

In Reference to Claims 2, 12, 19, and 29

Kirmse discloses wherein the client program assists the user in joining an individual {one of the selected individuals} in a game on the terminal by executing an instance of the game on the user terminal and connecting the terminal to a location hosting the game based on the connection status (para. 0010; 0054; 0056-57; also see rejection of Claims 1, 18, and 27-28)

In Reference to Claim 3

Kirmse discloses wherein the client program further generates a user interface that allows the user to join an individual in a game by selecting an icon (friend's identifier or smiley face icon) (Fig. 10; para. 0054; 0077).

In Reference to Claims 7, 14, and 21

Kirmse discloses wherein the connection status comprises an IP address hosting a corresponding game (para. 0035; 0086).

In Reference to Claim 8

Kirmse discloses wherein one or more servers (messenger server) receives the data and connection status and to communicate the data and connection status to the selected individuals (18, Fig. 1; 118, Fig. 12; para. 0010; 0053).

In Reference to Claims 9, 15, and 22

Kirmse discloses wherein the program allows the user to send and receive instant messages to and from selected individuals (para. 0029).

In Reference to Claims 10, 16, and 23

Kirmse discloses wherein the selected individuals include individuals stored on a friend list created by the user (para. 0003).

In Reference to Claims 11, 17, and 24

Kirmse discloses wherein the selected individuals include individuals stored on a friend list created by an individual stored on a friend list created by the user (para. 0003: since a user has a friend list (as shown in Figs. 8-10), then a friend on the list also has a friend list because both the user and the friend have the IM software).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. U.S. Patent Pub. No. 2002/0086732 to Kirmse (Kirmse) of record and in view of U.S. Patent Pub. No. 2004/0032876 to Garg (Garg) of record.

Kirmse discloses a system substantially equivalent to Applicant's claimed invention. Kirmse fails to disclose wherein the second program comprises an LSP program.

Garg teaches of a network system that uses an LSP to intercept data sent and received by a client device. Garg is silent to a gaming network but is analogous art as it addresses a common problem to be solved. Here, Garg concerns the transmission of data between terminal users over a network using a program appolication which can be separate program that the client program ("For example, CR 42 may be included as part of a client application, such as client application 21a (see FIG. 2). Or CR 42 component may be implemented as a separate executable "socket interceptor module", such as a Winsock Layered Service Provider (LSP) module that, when executed, intercepts data received by a client device, and data sent by a client application executing on that client device. As an example, a Winsock LSP module executing on network device 21 detects each attempt by network application 21a to initiate communication with another computer, such as peer computer 34." [0021]). Garb provides this system and method in order to facilitate accessing resources on the Internet (para. 0002).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the LSP module as taught by Garg into the teachings of Kirmse in order to facilitate accessing resources on the Internet. Specifically, to take advantage of current technology to monitor which server the user is connecting to so that an IP address can be obtained for other users to connect to the same server to play, for example, the same game.

Response to Arguments

10. Applicant's arguments filed 5/5/2009 have been fully considered but they are not persuasive. Applicant argues (see Applicant's Arguments/Remarks pages 8-10) that Kirmse does not disclose determining which games are executing and that it would be redundant to combine with a reference that has SDK code. Examiner respectfully disagrees. Upon review of the Arguments, Amended claims and Interview conversation, Examiner reasonably concludes that Kirmse assumes an SDK application is present and if not then the user can manually log on to the game server and join a game. If the manual process were to be automated then one would have to detect what the user is already enabling - an online connection, the ability to identify himself to a server, and to currently be executing the game. Thus, if Kirmse fails to disclose this process explicitly via his invocation code then it would be obvious to automate this process. Examiner did not have this reasoning at the time of the interview but has now come to this realization. Further, while not relying on prior art introducing SDK code, Examiner disagrees with Applicant that adding redundancy is a reason to support a lack of motivation to combine. A sound engineering principle is to make critical parts of a process redundant to increase system reliability. Thus, the rejection of the claims is maintained.

11. Applicant argues (see Applicant's Arguments/Remarks page10-11) that Kirmse fails to suggest a second program that determines a connections status of the executing games. Examiner respectfully disagrees and has responded to this as part of the rejection of the claims.

12. Applicant argues (see Applicant's Arguments/Remarks pages 11-12) that Garg is non-analogous art simply because it does not relate to gaming. Examiner respectfully disagrees. For art to be analogous, "The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed. " KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." See also MPEP 2141. Garb concerns online users and the selection of data channels to take advantage of current technology to monitor which server the user is connecting to so that an IP address can be obtained for other users to connect to the same server to play, for example, the same game.

13. Examiner appreciates Applicant taking the time to review Danieli and Beuk as suggested at the Interview. Applicant's arguments are persuasive and as such these references have not been applied.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is provided in the Notice of References Cited.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714